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Paper No. 8
EWH

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Food Depot, Inc.

Serial No. 76/162,482

Myron Amer for Food Depot, Inc.

Karen M. Strzyz, Trademark Examining Attorney, Law Office 111 (Craig Taylor, Managing Attorney).

Before Hanak, Quinn and Hohein, Administrative Trademark Judges.

Opinion by Hanak, Administrative Trademark Judge:

Food Depot, Inc. (applicant) seeks to register in typed drawing form FOOD DEPOT OF NEW YORK for services which applicant subsequently identified as “wholesale distributorship featuring the sale of food and quantities of food for the restaurant market.” The intent-to-use application was filed on November 13, 2001. At the request of the Examining Attorney, applicant disclaimed the exclusive right to use FOOD and NEW YORK apart from the mark in its entirety.

In her second and final Office Action dated October 9, 2001, the Examining Attorney refused registration on two grounds. First, the Examining Attorney contended that applicant's recitation of services was "unacceptable as indefinite." Second, the Examining Attorney contended that applicant's mark, as applied to applicant's services, is likely to cause confusion with the mark FOOD DEPOT, previously registered in typed drawing form for "retail food store services." Registration No. 2,111,099 issued November 4, 1997.

When the refusal to register was made final, applicant appealed to this Board. Applicant and the Examining Attorney filed briefs. Applicant did not request a hearing.

We will first consider the refusal on the basis that applicant's amended identification of services is "unacceptable as indefinite." As just noted, these were the words which the Examining Attorney used in her second and final Office Action dated October 9, 2001. It should be noted that in her brief, the Examining Attorney does not explain why applicant's amended identification of services

is unacceptable. In other words, in her brief the Examining Attorney did not repeat her contention that applicant's amended identification of services is unacceptable because it is "indefinite." (Examining Attorney's brief pages 2 and 10).

By way of background, applicant's original identification of services was "wholesale distribution of food products to restaurants." In the first Office Action dated April 2, 2001, the Examining Attorney contended that the foregoing identification of services was "unacceptable as indefinite." She suggested that the applicant may adopt the following recitation of services if accurate: "wholesale distributorship featuring food for the restaurant market."

In response, applicant amended its identification of services to "wholesale distributorship featuring the sale of food and quantities of food for the restaurant market." In the second and final Office Action the Examining Attorney, as previously noted, held that the amended identification of services was "also unacceptable as

indefinite." At no time has the Examining Attorney explained why applicant's initial or amended identification of services were unacceptable as "indefinite."

To cut to the quick, we find that applicant's amended identification of services is proper, and is not indefinite. Accordingly, the refusal to register on the basis that applicant's amended identification of services is indefinite is reversed.

We turn now to the second ground of refusal premised on Section 2(d) of the Trademark Act, namely, that applicant's mark, as applied to applicant's services, is likely to cause confusion with the mark FOOD DEPOT, previously registered in typed drawing form for "retail food store services." In any likelihood of confusion analysis, two key, although not exclusive, considerations are the similarities of the marks and the similarities of the goods. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the

marks.")

Considering first the marks, note that the only component common to both marks are the words FOOD DEPOT. However, as applied to registrant's services (retail food store services) and especially as applied to applicant's services (wholesale distributorship featuring the sale of food and quantities of food for the restaurant market), the words FOOD DEPOT are extremely suggestive. In this regard, we note that both applicant and registrant have disclaimed any exclusive rights to the word FOOD. Moreover, we take judicial notice that the word "depot" is defined as "a storehouse; warehouse." Webster's New World Dictionary (2d ed. 1975). Thus, the registered mark FOOD DEPOT is synonymous with FOOD WAREHOUSE, and applicant's mark FOOD DEPOT OF NEW YORK is synonymous with FOOD WAREHOUSE OF NEW YORK. It has been held that the mere presence of a highly suggestive common component in two marks is "usually insufficient to support a finding of likelihood of confusion." Tektronix, Inc. v. Daktronics, Inc., 534 F.2d 915, 189 USPQ 693, 694 (CCPA 1976). It is with this proposition in mind that we turn to a comparison of

applicant's services and registrant's services. However, before so doing, we wish to make it clear that we have not impermissibly characterized the registered mark FOOD DEPOT as being merely descriptive. Rather, we have properly characterized the registered mark FOOD DEPOT as being extremely suggestive. In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 752 (Fed. Cir. 1985).

Turning to a consideration of the respective services of applicant and registrant, we note that the only evidence made of record by the Examining Attorney in an effort to show that the services are related are 29 third-party registrations. In 17 of these 29 registrations, the services include essentially the wholesale and retail sale of various food items. The other 12 registrations include the wholesale and retail sale of other products. It is the position of the Examining Attorney that these 29 third-party registrations demonstrate that "registrant's grocery store and applicant's wholesale distributorship are likely to be marketed to the same class of purchasers under circumstances which would give rise to a mistaken belief that they originate from or are in some way associated with

the same source." (Examining Attorney's brief page 10).

We do not dispute that there are common purchasers of registrant's "retail food store services" and applicant's "wholesale distributorship featuring the sale of food and quantities of food for the restaurant market." However, those common purchasers are an extremely narrow and, when it comes to food items, sophisticated segment of the general population, namely, owners and operators of restaurants. Obviously, almost all Americans partake of "retail food store services," registrant's services. However, only owners and operators of restaurants would partake of "wholesale distributorship featuring the sale of food and quantities of food for the restaurant market," applicant's services.

When it comes to purchasing food items, owners and operators of restaurants are clearly sophisticated purchasers. This is true when they purchase food at the wholesale level for their restaurants, and it is likewise true when they purchase food at the retail level for their own consumption. In other words, owners and operators of

restaurants in their off hours do not suddenly become unsophisticated when it comes to the purchase of food items.

Our primary reviewing Court has made it abundantly clear that in any likelihood of confusion analysis, purchaser "sophistication is important and often dispositive because sophisticated consumers may be expected to exercise greater care." Electronic Design & Sales v. Electronic Data Systems, 954 F.2d 713, 21 USPQ2d 1388, 1392 (Fed. Cir. 1992). We are of the view that sophisticated purchasers of food items would not assume that FOOD DEPOT retail food store services and FOOD DEPOT OF NEW YORK wholesale food distribution services to restaurants are related merely because both marks contain the extremely suggestive words FOOD DEPOT. Accordingly, we reverse the refusal pursuant to Section 2(d) of the Trademark Act.

Decision: The refusal to register on the basis that applicant's amended identification of services is indefinite is reversed. The refusal to register pursuant to Section 2(d) of the Trademark Act on the basis that applicant's mark, as applied to applicant's services, is

likely to cause confusion with the mark FOOD DEPOT for retail food store services is likewise reversed.